

REMARKS

Claims 1-28 are pending and claims 1-28 stand rejected. By virtue of this response, no claims have been cancelled, amended, or added. Accordingly, claims 1-28 are currently under consideration.

For the Examiner's convenience, Applicants' remarks are presented in the same order in which they were raised in the Office Action.

Claim Rejections under 35 U.S.C. 103(a)

A. Claims 1-7, 9, 11-15, 17, 19, 23, 25-26 and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Pub. 20030137766 A1) in view of Kingbright (3.65X6.15mm SINGLE CHIP LED BARS).

Applicants respectfully traverse the rejection and submit that the Examiner has failed to present a *prima facie* case of obviousness because the combination fails to disclose all of the features of the present claims, and the combination fails to provide a teaching, suggestion, or motivation to modify the primary reference to meet the features the present claims.

Applicants submit that the combination fails to disclose each and every feature of claim 1 and is improperly relying on inherency in the rejection. MPEP §§ 2143, 2112. In particular, Applicants submit that Ellis fails to disclose or suggest "determining a distance between the calibration mark and a reference position based on the shift in the detected calibration mark, the offset position, and a focal length associated with the at least one sensor used to detect the calibration mark," as recited by claim 1 (and similarly by claims 12 and 23).

The Examiner has failed to illustrate that the above recited features are either "expressly or inherently described" by the references. MPEP § 2131. Ellis clearly does not expressly disclose the above recited features of claim 1, and thus the Examiner is (or at least appears to be) relying on inherency to support the rejection, i.e., that the disclosure of "optical sensors" in paragraph [0031] inherently discloses determining the distance based on a focal length of a sensor. Such analysis,

however, requires the Examiner to show that the feature is necessarily disclosed by Ellis. MPEP § 2112 (e.g., the rationale or evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999)).

In this instance, the Examiner has provided no evidence or rationale leading to a conclusion that the recited claim features are necessarily disclosed by Ellis (i.e., determining a distance “based on ... focal length”), and has at best suggested that an optical sensor may have a focal length (which Applicants do not concede, e.g., an optical sensor adapted to merely detect light incident thereon does not necessarily include a focal length associated therewith). For example, even if the optical sensor disclosed by Ellis inherently or necessarily has a focal length, the disclosure nevertheless fails to disclose or suggest determining a distance based on, *inter alia*, the focal length, as recited by claim 1. The Examiner has provided no evidence or line of reasoning to show that Ellis necessarily discloses a distance measurement based on a focal length of the optical sensors, and therefore the Examiner’s analysis is clearly insufficient to maintain the rejection. MPEP §§ 2112 and 2131.

Furthermore, Applicants submit that Ellis appears to disclose measuring relative lateral positioning (e.g., along the X and Y axes) of cartridge gripper 22 with calibration cartridge 20 (see, e.g., paragraph [0032] and Figs. 1-4, which appear to teach away from measuring depth along the Z axis). For example, paragraph [0086] suggests that the X and Y lateral positions are determined via detector 92 and radiation from exit aperture 44, while the Z position, or depth, is “known from the Z position of cartridge gripper 22.” Accordingly, Ellis does not appear to disclose measuring a distance along the Z axis, e.g., relating to a distance from the picker mechanism/sensor to the calibration mark. This is in clear contrast to measuring a distance related to the depth or distance between a calibration mark and a reference position associated with a picker as recited by the present claims (e.g., claims 4, 5, 15, and 23). For example, claim 4 recites wherein “the reference position is associated with a robotic picker mechanism.” Accordingly, the distance measured

includes a distance along the Z axis or depth from the picker mechanism to the calibration mark, which is not disclosed or suggest by the disclosure of Ellis.

The combination of Ellis with Kingbright does not cure the deficiencies of Ellis discussed above, nor is it alleged to cure the deficiencies. In particular, the disclosure of Kingbright does not disclose or suggest determining a distance based on, at least in part, the focal length of a sensor. Accordingly the combination of Ellis and Kingbright fails to disclose or suggest the features of claims 1, 12, and 23, and the rejection must be withdrawn.

Finally, the rationale for the combination and modification to Ellis proposed by the Examiner is insufficient to support a *prima facie* case of obviousness as the rationale does not provide sufficient teaching, suggestion, or motivation to modify the disclosure of Ellis to meet the features of the present claims. (MPEP § 2143.01, e.g., “The prior art must suggest the desirability of the claimed invention”). Even assuming the rationale provided by the Examiner suggests combining the references, the Examiner has not provided any evidence or line of reasoning that the references suggest the desirability for modifying the system of Ellis to meet the features of the present claims. In fact, the Examiner has not provided any rationale or line of reasoning as to why one of ordinary skill in the art would include a rectangular LED with the system of Ellis. For example, the system of Ellis includes a cartridge case 30 having a transmissive channel 40 therein to transmit light incident on a reception port 42 to an exit aperture 44 (see, e.g., the Abstract). There does appear to be any suggestion to include an LED with the cartridge case 30, let alone, modify the cartridge case 30 in some fashion to meet the features of the present claims. Nor does the combination appear to suggest determining a distance based on a focal length as recited. Accordingly, the rationale for combining the references to meet the features of the present claims is clearly lacking and the rejection should be withdrawn.

Therefore, for at least the reasons discussed above, Applicants request withdrawal of the rejection and allowance of claims 1, 12, and 23 (and those claims depending therefrom).

B. Claims 8, 10, 18, 20-21, and 27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view of Kingbright as applied to claims 1, 12 and 23 above, and further in view of Ellis (U.S. Pat. No. 5,237,468).

Claim 8, 10, 18, 20, 21, and 27 depend from claims 1, 12, and 23 respectively and are allowable over Ellis and Kingbright for at least similar reasons discussed above. Accordingly, the rejection should be withdrawn.

C. Claims 16 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis in view Kingbright as applied to claims 16 and 23 above, and further in view of Ellis (U.S. Pat. No. 6,385,003).

Claim 16 and 24 depend from claims 12 and 23 respectively and are allowable over Ellis and Kingbright for at least similar reasons discussed above. Accordingly, the rejection should be withdrawn.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 249212025700. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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